REMARKS

Claims 1-20 are pending in the application. Dependent claim 21 is added by this amendment. Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. In particular, the Examiner asserts that the language " transforming physical media into a chart..." in claim 1 renders that claim and its dependent claims indefinite. Applicant has amended that language to more clearly set forth the recited aspect of the invention. Attached hereto is a copy of the present claims showing this and other amendments made herein.

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blake et al., "The Managerial Grid." Applicant has amended the claims and also respectfully traverses for the reasons set forth below.

As an initial matter, Applicant notes that, while the Board Decision in the parent application addressed briefly the Section 103 rejection in the parent case in view of Blake et al., the claims considered were substantially different than the present claims. In particular, the claims considered by the Board did not include any of the amendments made in the unentered Amendment filed November 24, 1997, nor any language introduced into the claims in the present Continuation-In-Part application.

The Examiner asserts that Blake et al. disclose two variables, criteria statements, first and second scores, a chart with two axes each relating to one of the variables, and plotting a point on the chart corresponding to the first and second total scores. Applicant respectfully disagrees for the reasons set forth below, and notes that the claims include further limitations other than those addressed by the Examiner.

Applicant' s claimed invention is a *quantitative* system which uses actual metrics for analyzing a specific asset by collecting and summing score data and calculating and plotting

a position on a chart in accordance with the scores. Claim 1 of the present application requires, *inter alia*:

> **..scoring each of said performance criteria statements;**
>
> **summing a plurality of scores obtained by said scoring step to generate first and second total scores based upon the extent to which individual statements accurately describe said intangible asset of interest...**
>
> **physically plotting a point on said chart, said point being located at coordinates corresponding to said first and second total scores, respectively; and....**

Blake et al., on the other hand, merely disclose a chart which is intended to express the differences between several managerial styles and does not teach or suggest any quantitative system for analyzing a specific asset. In this regard, claim 1 has been amended to clarify this aspect of the invention. Blake et al. fail to teach or suggest the recited step of scoring performance criteria statements, fail to teach or suggest the recited step of summing a plurality of scores obtained by that scoring step, and fail to teach or suggest physically plotting a point on a chart at a location corresponding to first and second total scores. The numbers used on the two axes are not scores at all, and are certainly not sums of performance criteria statement scores. The 9,9, 9,1, 1,9, 5,5, 1,1 values on Figure 1 of Blake et al. are used only to identify portions of the grid. These values are not used for calculating chart positions; Blake et al. could equally well have used words alone to define the five management styles.

The significance of the numbering scheme shown on Figure 1 of Blake et al. can be seen clearly from Chapter 3 thereof, a copy of which is attached hereto. While Applicant does not consider Chapter 3 relevant to patentability, the chapter is being submitted to the Examiner to add context to the cited portions of Blake et al. and thereby assist in clarification of exactly what the reference discloses and the distinctions between the reference and the claimed invention.

For example, in Chapter 3, Blake et al. describe the characteristics of the 9,1 Management Style in words, describing how the following issues are handled in this management approach: the concept of goals, boss-subordinate relationships, creating and maintaining morale, communication activities, approaches to managing conflict, impact on creativity and change, commitment, management development, personal behavior. There is no teaching or suggestion of performing any calculations in this respect; there is no plotting of a position on the grid. There are only descriptions of the behavior related to "9,1 Management."

Chapters 4, 5, 6 and 7 repeat the above analysis for each of the other four grid positions. There is likewise no disclosure in those chapters of calculations to generate particular chart positions.

The numbers associated with the axes in the cited portion of Blake et al. are merely used as labels for each management style; the actual values of these numbers are superfluous to Blake's disclosure, which relates to the distinctions between different management styles. The inclusion of these axis labels does not teach or suggest the presently claimed quantitative process for producing a chart, which includes the steps of scoring performance criteria statements, summing scores, and physically plotting a point on the chart corresponding to first and second scores.

In the above regard, claim 1 has been amended to clarify that the invention is a method for analyzing a specific intangible asset of interest and that the scoring step comprises a step of calculating scores which reflect the applicability of performance criteria statements to that specific intangible asset of interest

The Examiner recognizes that Blake et al. does not teach the use of the chart produced in accordance with the steps discussed above in making at least one decision regarding the value of an intangible asset of interest. While the Examiner argues that this would have been obvious to one skilled in the art in view of official notice that graphical illustrations are used to represent data in order to aid in decision-making, Applicant

respectfully disagrees. As set forth above, The Managerial Grid discloses a chart for aiding in the understanding of different managerial styles, and does not teach or suggest the claimed steps for calculating a numerical value for a particular intangible asset of interest in order to analyze that intangible asset. Blake et al. do not calculate a single grid position. Thus, it is respectfully submitted that The Managerial Grid, even when combined with the official notice taken by the Examiner, would not suggest the claimed step of using the chart produced in accordance with the steps discussed above in making at least one decision regarding the value of an intangible asset of interest.

In view of all of the above, The Managerial Grid fails to teach or suggest at least the claimed steps of scoring performance criteria statements, summing scores, physically plotting a point on a chart corresponding to first and second scores, and using the chart thus produced in making at least one decision regarding the value of an intangible asset of interest. It is well-established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. In Re Boyka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (C.C.P.A. 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (C.C.P.A. 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (C.C.P.A. 1973).

Furthermore, Applicant has amended claim 1 to include the limitations of claim 5, which required that the first and second variables be independent variables. While the Examiner asserts that The Managerial Grid uses two independent variables, Applicant disagrees. As set forth above, the variables disclosed by Blake et al. in The Managerial Grid are not independent. Blake teaches that whenever a person acts as a manager, he is "achieving organizational purposes of production through people". (Chapter 2, Page 8). Concern for people and concern for production are always present and are not independent variables. Blake teaches that individuals have concern for both variables in different degrees and in fact this varies in any individual depending on the circumstances. Blake states that two or more of the basic approaches to management (9,9, 5,5, 9,1, 1,9, 1,1) can be "used either simultaneously or successively in conjunction with one another". (Chapter 9, page 212).

Blake describes "wide-arc pendulum" management in which the 9,1 and 1,9 management positions are connected with one another and "operate in juxtaposition". (Chapter 9, Page 216). By contrast, each of the variables in the Applicant's claimed invention can be met independently of one another. For example, in the embodiment of claim 8, high technical strength of a technological asset can be met independently of its commercial strength, a situation faced frequently by inventors.

With respect to claim 2, for the reasons set forth above, Applicant respectfully disagrees with the Examiner's statement that Blake et al. disclose scores for a plurality of criteria statements. With respect to claim 3, Applicant sees no inherent disclosure in Blake et al. of the claimed weighting of factors in determining first and second total scores. Nothing in Blake et al. suggests weighting at all and, as set forth above, Blake et al. do not calculate total scores. With respect to claims 6-17, while the Examiner recognizes that Blake et al. do not teach the use of the disclosed grid in analysis of the assets recited in these claims, Applicant respectfully disagrees with the unsupported statement that such an application would have been obvious. With respect to claim 18, all of the arguments set forth above distinguishing claim 1 are fully applicable to claim 18 and are incorporated herein.

In view of all of the above, claims 1-18 as amended herein are allowable over the cited art.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over The Managerial Grid in view of Turnbull. All of the arguments set forth above with respect to independent claim 1 are fully applicable to dependent claims 19 and 20, and are incorporated herein. Additionally, the disclosure of Turnbull, like that of Blake et al., is qualitative in nature. Applicant agrees with the Examiner's assertion that Turnbull suggests assessment by graphic representation of current and future positions of a company. Applicant further agrees with the Examiner that the last two paragraphs of page 12 of Turnbull disclose generating future business portfolios based on project trends of certain factors in order to

identify major strategic issues facing the company. However, Applicant sees no teaching or suggestion in Turnbull of the recited steps of calculating the future value by:

> **iterating said scoring, summing, transforming, and plotting steps using new rating levels, determined through a code in the format x, y, z where x is a number of improvement steps which the asset is likely to achieve if its current position is at a lowest performance level, y is a number of improvement steps that the asset is likely to achieve if its current position is at a next highest performance level, and z is a number of improvement steps the asset is likely to achieve if its current position is at a next highest performance level.**

There is simply no teaching or suggestion in any portion of Turnbull, particularly in the cited pages 7 and 12, of the above-recited calculating steps. Turnbull merely teaches generating future business portfolios based on project trends of certain factors, and this does not render obvious the above steps. In order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. In re Boyka, *supra*.

In view of the above, dependent claims 19 and 20 are allowable over the cited art.

Dependent claim 21 has been added by this amendment. This claim is believed to be patentable for the same reasons set forth above with respect to claim 1, from which claim 21 depends. The new claim has been carefully drafted so as not to add new matter to the application. Support for claim 21 may be found in Applicant's specification at, e.g., page 6, lines 12-15, and page 7, lines 8-12.

CONCLUSION

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that claims 1-4 and 6-21 are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,

Richard E. Kurtz, II (Reg. No. 33,936)
Attorney for Applicants

GREENBERG TRAURIG
1750 Tysons Boulevard, 12th Floor
McLean, VA 22102
(703) 749-1330
E-mail: kurtzr@gtlaw.com

Filed: 10/2/01

COPY OF CLAIMS SHOWING AMENDMENTS

1. A method of manufacturing a chart reflecting the value of ~~an~~ a specific intangible asset of interest, comprising the steps of:

establishing a first independent variable and a second independent variables related to the value of said specific intangible asset of interest;

establishing a series of performance criteria statements probative of the value of said first and second independent variables;

scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest;

summing a plurality of scores obtained by said scoring step to generate first and second total scores based upon the extent to which individual statements accurately describe said intangible asset of interest;

transforming physical media into a chart ~~having~~by physically plotting on said media a first axis relating to said first variable and a second axis relating to said second variable;

physically plotting a point on said chart, said point being located at coordinates corresponding to said first and second total scores, respectively; and,

using said chart in making at least one decision regarding the value of said intangible asset of interest.

2. The method of claim 1, wherein said generating step comprises the steps of:

choosing, from sets of performance criteria statements in said series,

individual statements which most accurately describe said intangible asset of interest;

determining, for each said set of performance criteria statements, first and second scores based at least in part on the particular statement chosen from the set, said first and second scores relating to said first and second variables, respectively;

summing a plurality of said first scores to obtain a first total score relating to said first variable; and,

summing a plurality of said second scores to obtain a second total score relating to said second variable.

3. The method of claim 1, further comprising the steps of:

assigning to each said performance criteria statement first and second weighting factors reflecting an extent of impact of said statement on said value of said first and second variables, respectively;

using said weighting factors in determining said first and second total scores.

4. The method of claim 1, further comprising the step of:

placing a label in each of four quadrants of said chart, or in such other zones in which said chart may be divided, each label representing the extent to which points in a quadrant reflect a balance between said first and second variables.

~~5. The method according to claim 1, wherein said first and second variables comprise two independent variables.~~

6. The method according to claim 1, wherein said intangible asset of interest comprises a technological asset and wherein said first variable comprises commercial strength.

7. The method according to claim 1, wherein said intangible asset of interest comprises a technological asset and wherein said second variable comprises technical strength.

8. The method according to claim 1, wherein said intangible asset of interest comprises a technological asset and wherein said first variable comprises commercial strength and said second variable comprises technical strength.

9. The method according to claim 1, wherein said intangible asset of interest comprises a research and development organization and wherein said first variable comprises short-term performance.

10. The method according to claim 1, wherein said intangible asset of interest comprises a research and development organization and wherein said second variable comprises long-term performance.

11. The method according to claim 1, wherein said intangible asset of interest comprises a research and development organization and wherein said first variable comprises short-term performance and said second variable comprises long-term performance.

12. The method according to claim 1, wherein said intangible asset of interest comprises a university and wherein said first variable comprises research excellence.

13. The method according to claim 1, wherein said intangible asset of interest comprises a university and wherein said second variable comprises teaching excellence.

14. The method according to claim 1, wherein said intangible asset of interest comprises a university and wherein said first variable comprises research excellence and said second variable comprises teaching excellence.

15. The method according to claim 1, wherein said intangible asset of interest comprises a private-sector company and wherein said first variable comprises the strength of today's business.

16. The method according to claim 1, wherein said intangible asset of interest comprises a private-sector company and wherein said second variable comprises tomorrow's business.

17. The method according to claim 1, wherein said intangible asset of interest comprises a private-sector company and wherein said first variable comprises the strength of today's business and said second variable comprises the strength of tomorrow's business.

18. A chart for providing a graphical indication of the value of an intangible asset of interest, wherein said chart is created according to the method of claim 1.

19. The method according to claim 1, further comprising the steps of:

calculating the future value of an intangible asset by iterating said scoring, summing, transforming, and plotting steps using new rating levels, determined through a code in the format x, y, z where x is a number of improvement steps which the asset is likely to achieve if its current position is at a lowest performance level, y is a number of improvement steps that the asset is likely to achieve if its current

position is at a next highest performance level, and z is a number of improvement steps the asset is likely to achieve if its current position is at a next highest performance level.

20. The method according to claim 1, further comprising the steps of:

repeating said steps of establishing, scoring, summing, transforming, and plotting for a plurality of intangible assets of interest, whereby said chart is caused to show a plurality of points corresponding to said plurality of intangible assets of interest.

21. The method of manufacturing a chart in accordance with claim 1, further comprising the step of:

establishing a third independent variable related to the value of said specific intangible asset of interest; and,

plotting on said media a third axis relating to said third independent variable.